a2 concld

selected from the group consisting of multiwell plates, arrays of pits and multiwell supports comprising nanoliter wells.

8~~8~~. (Amended) A process of making a bead conjugated to a solid support and further conjugated to a nucleic acid, comprising the steps of conjugating a bead to a nucleic acid; and conjugating a bead to a solid support, wherein the solid support is selected from the group consisting of multiwell plates, arrays of pits, and multiwell supports comprising nanoliter wells.

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REMARKS

A check for the fees for a three month extension of time, a Petition to correct inventorship, and excess claims (4 independent claims and 4 excess claims) accompanies this response. If no check is provided, the fee for extension of time and any other fees that may be due in connection with this paper or with this application during its entire pendency may be charged to Deposit Account No. 08-1641. If a Petition for extension of time is needed, this paper is to be considered such Petition.

The specification is amended at page 14, line 28, to correct an obvious typographical error. Accordingly, the amendment of the specification raises no issue of new matter.

Claims 1-5, 7-24 are pending in the application. Claim 6 is cancelled and claims 1 and 9 are amended by cancellation of species (previously claimed in the parent applciation). Claims 15-24 are added to capture embodiments from original claims 1 and 9. In particular, claims 15-24, find particular basis in original claims 1-14 and in the specification as originally filed. For example, basis may be found at page 7, lines 13-31, and page 13, lines 16-29. Therefore, no new matter has been added.

THE REJECTION OF CLAIMS 1-14 UNDER 35 U.S.C. §101

Claims 1-14 are rejected under 35 U.S.C. § 101 for statutory double patenting over claims 1-19 of copending U.S. Application No. 08/746,036.

Reconsideration of the grounds for this rejection is respectfully requested in view of the amendments herein and the following remarks.

Relevant law

Statutory double patenting under 35 U.S.C. §101 exists when two or more patents are granted that contain claims that encompass the same inventive concept. Thus, in order for such a rejection to be proper, the claims of both applications must be of the same scope. The test for double patenting under 35 U.S.C. §101 is whether it is possible to infringe the claims of one application without infringing the claims of the other application. If it is possible to infringe the claims of one application and not the other, the claims are of different scope.

Analysis

In this instance it is possible to infringe the claims of this application without infringing the claims of allowed U.S. application Serial No. 08/746,036. Claims 1 and 9 as well as the dependent and added claims are of different scope from the claims in parent application U.S. application Serial No. 08/746,036. For example, claims 1 and 9 specify embodiments to which each is directed. Each recites multiwell plates, arrays of pits and supports that comprise nanoliter wells. The claims in the parent application specifically recite embodiments other than arrays of pits, multiwell plates and supports that comprise nanoliter wells. Accordingly, it is would be possible to infringe the parent application, but not infringe claims 1 and 9. Similarly, all of the presently pending claims, which recite species that are not specifically claimed in the parent application, are of a different scope from the claims in the parent application. Therefore, as between the instant claims and the parent application statutory double patenting does not exist.

CHANE IN INVENTORSHIP

Upon review of the claims in this application, it was noticed that inventorship for the application was incorrect as filed. A Petition under 37

C.F.R. §1.48(a) to removed Dirk Reuter and G. Scott Higgins as inventors accompanies this response. Also provided are:

(a) statements signed by Dr. Reuter and Dr. Higgins (a facsimile copy) indicating that the error in inventorship in the above-referenced application occurred without deceptive intent on the part of each;

(b) an oath and declaration signed by the actual inventors;

(c) a check including the fee set forth in 37 C.F.R. §1.17(i) ($130.00);

(d) written consent of Sequenom Inc., assignee of the entire title, right and interest in the above-captioned application; and

(e) a Certificate under 37 C.F.R. §3.73(b) establishing ownership of the instant application by Sequenom Inc (with a copy of the assignment).

A facsimile copy of the statement of Dr. G. Scott Higgins is provided. The original will be sent under separate cover upon receipt.

* * *

In view of the above remarks and the amendments and remarks of record, consideration and allowance of the application are respectfully requested.

Respectfully submitted,
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